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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,656	06/09/2008	Hyung-Joo Kwon	BARUN-10974	3937
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Casimir Jones, S.C. 2275 DEMING WAY, SUITE 310 MIDDLETON, WI 53562				
EXAMINER				
OGUNBIYI, OLUWATOSIN A				
ART UNIT		PAPER NUMBER		
1645				
MAIL DATE		DELIVERY MODE		
06/21/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/581,656

**Applicant(s)**

KWON ET AL.

**Examiner**

OLUWATOSIN OGUNBIYI

**Art Unit**

1645

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/5/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2 and 6-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 8 is/are allowed.
- 6) ☒ Claim(s) 2, 6, 7, 9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: appendix a

### **RESPONSE TO AMENDMENT**

1. The amendment filed 6/5/09 has been entered into the record. Claims 1-2 and 6-7 have been amended. Claims 8-10 have been added. Claims 1-2 and 6-10 are pending in the application and are under examination.

### ***Sequence Requirements***

2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. § § 1.821-1.825 for the reason(s) set forth below. Full compliance with the sequence rules is required in response to this office action.

The specification discloses sequences on p. 12 line 23, p. 13 lines 1-3, line 19, p. 18 line 9, lines 11-12, 14-15, p. 21 line 10, p. 22 lines 22-23 and figures 3, and 6 disclose sequences encompassed by the definitions for nucleotide sequences set forth in 37 C.F.R. § 1.821(a)(1) and (a)(2). These sequences are not identified by the requisite sequence identification # i.e. SEQ ID NO:.

*Please identify the sequences in the specification on p. 12 line 23, p. 13 lines 1-3, line 19, p. 18 line 9, lines 11-12, 14-15, p. 21 line 10, p. 22 lines 22-23 by their sequence identification numbers.*

### ***Drawings***

3. The amendment to the drawings filed 6/5/09 has been entered into the record.

***Specification***

4. The objection because on p. 31 line 5 there is a word missing between 'every five' and 'during 2 weeks' is withdrawn in view of the amendment filed 6/5/09.

***Claim Objections-Withdrawn***

5. The objection to claims 3-7 is withdrawn in view of the amendment to the claims.

***Claim Rejections - Withdrawn***

6. The rejection of claims 1-7 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter is withdrawn in view of the amendment to the claims.

7. The rejection of claims 1-7 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of the amendment to the claims.

8. The rejection of claims 1-7 under 35 U.S.C. 112, first paragraph, (scope of enablement) is withdrawn in view of the amendment to the claims.

9. The rejection of Claims 1 and 3-5 under 35 U.S.C. 112, second paragraph is withdrawn in view of the amendment to the claims.

***Claim Objections-New***

0. Claims 2 and 7 are objected to because of the following informalities:

In claim 2 line 2, "presented in following General" should be "presented in the following General".

In claim 7, line 2, "wherein the oligonucleotides are selected from the group consisting of oligonucleotide is", should be "wherein the oligonucleotides are selected from the group consisting of".

Appropriate correction is required.

***Rejections Maintained***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. The rejection of claim 2, 6, 7 and applied to new claim 9 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is maintained.

As to claim 2, the claim recites "isolated oligodeoxynucleotides presented in following general formula, at 5'terminal and a 3' terminal end:

The metes and bounds of the claimed oligonucleotides is not clear because it is not clear what structure is at a 5' terminal and a 3' terminal end, and of what. Please clarify the language of the claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Wang et al. US 20040029129.

The claim is drawn to a composition comprising an isolated oligonucleotide having the nucleic acid sequence of SEQ ID NO: 3, wherein said oligonucleotide treats atopic dermatitis or protects normal immune cells when radiotherapy is applied.

Wang et al teach a composition comprising an isolated oligonucleotide having (or comprising) the nucleic acid sequence that is 100% identical to SEQ ID NO:3. See attached sequence alignment (Appendix A) with SEQ ID NO: 26331 of Wang et al. See Wang et al paragraph 1145, 1166 and 1180. the recitation that "wherein said oligonucleotide treats atopic dermatitis or protects normal immune cells when radiotherapy is applied" is directed to an intended use of the claimed oligonucleotide,

however, the oligonucleotide of Wang et al meets the structural limitation of the claims and is capable of performing the intended use absent other evidence to the contrary.

### ***Status of Claims***

Claims 2, 6-7 and 9-10 are rejected. Claims 1 and 8 are allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUWATOSIN OGUNBIYI whose telephone number is 571-272-9939. The examiner can normally be reached on M-F 8:30 am- 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Mondesi can be reached on 571-272-0956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Oluwatosin Ogunbiyi/

Examiner, Art Unit 1645

/Robert B Mondesi/

Supervisory Patent Examiner, Art Unit 1645